

Application No. 10/086,805

REMARKS

Claims 1-16 are in the application and subject to a restriction requirement. According to the Examiner, the application contains claims directed to the following patentably distinct inventions:

- I. Claims 1-6, drawn to an apparatus for identifying the molecular structures within a sample substance.
- II. Claims 7-16, drawn to a method for identifying molecular structures within a sample substance.

In response to the restriction requirement, Applicant provisionally elects Invention II (claims 7-16) solely for the purpose of advancing the case, but such election is made with traverse.

It is believed that the requirement to restrict the invention is improper and that the subject matter is sufficiently related such that examination in separate applications will cause duplication of effort and that it is a more efficient use of Patent Office manpower and resources to examine all of the claims at one time rather than conducting separate examinations.

Moreover, restriction is not "required" by 35 U.S.C. § 121 as suggested by the Examiner. Congress wisely gave the Commissioner the "discretion" to require restriction. According to 35 U.S.C. § 121 "... the Commissioner may require the application to be restricted...." (emphasis added). Likewise, MPEP. § 803 lists two criteria that must be present for restriction to be proper:

- 1) The invention must be independent or distinct; and
- 2) There must be a serious burden on the Examiner if restriction is not required (emphasis added).

The Examiner has not shown any serious burden if examination of all of the claims is conducted at one time. It is therefore respectfully requested that the Examiner reconsider and withdraw the restriction requirement.

Application No. 10/085,162

Election of Species

According to the Examiner, with regard to Invention II, the application contains claims directed to the following patentably distinct species:

oligonucleotide probes, antibody pieces, ligands or ligand analogs, and protein or peptide probes.

In response, Applicant provisionally elects oligonucleotide probes solely for the purpose of advancing the case, but such election is made with traverse. The claims of Group II readable thereon are: Claims 7-8 and 12-16.

In the event this response is not timely filed, Applicant hereby petitions for the appropriate extension of time and request that the fee for the extension along with any other fees which may be due with respect to this paper be charged to our Deposit Account No. 12-2355.

Respectfully submitted,

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**\* \* \*CERTIFICATE OF FACSIMILE TRANSMISSION\* \* \***

I hereby certify that this correspondence consisting of 4 pages (1 cover sheet and 3 page Response) is being facsimile transmitted to the Patent and Trademark Office to: Fax Number 703-872-9306, ATTN: Examiner Nelson YANG, Group Art Unit 1641.

Date February 10, 2004

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